

Amendment D
USSN 09/925,883

Attorney Docket R0072B-RUG

REMARKS

Amendments

The claims above are amended to delete non-elected subject matter. No new matter is added thereby. Claims 28-29 have been amended to change "disease" to "disease or condition": this is supported in the specification at page 26, line 17 (paragraph [0155] as published). No new matter is added thereby.

Restriction Requirement

As a point of clarification, Applicants note that Ar has always been defined as "optionally substituted phenyl" in the claims. Pursuant to the definition of this phrase in the specification at page 6, lines 10-18, optionally substituted phenyl may be unsubstituted, or substituted with one to four substituents selected from alkyl, cycloalkyl, cycloalkylalkyl, halo, nitro, cyano, hydroxy, alkoxy, amino, acylamino, monoalkylamino, dialkylamino, haloalkyl, haloalkoxy, heteroalkyl, -COR (where R is H, alkyl, phenyl, or phenylalkyl), -(CR'R'')_n-COOR (where n is an integer from 0 to 5, R' and R'' are each independently H or alkyl, and R is H, alkyl, cycloalkyl, cycloalkylalkyl, phenyl, or phenylalkyl), or -(CR'R'')_n-CONR^aR^b (where n is an integer from 0 to 5, R' and R'' are each independently H or alkyl, and R^a and R^b are each independently H, alkyl, cycloalkyl, cycloalkylalkyl, phenyl, or phenylalkyl). However, the restriction requirement set forth in the Office action mailed on January 14, 2003 (as well as the restatements thereof in the Office action mailed on March 24, 2003, and in the present Office action mailed July 16, 2004), the radical Ar definition has been stated "Ar is phenyl substituted halogen or alkoxy...". This would omit both unsubstituted phenyl and phenyl substituted with alkyl, cycloalkyl, nitro, cyano, hydroxy, amino, and others. However, because these omitted substitutions are not present in any of the Groups, Applicants have assumed that the Examiner intended to include all "optionally substituted phenyl" compounds as defined in the specification in each Group. Applicants would like clarification as to the scope of the restriction requirement, and would appreciate restatement of restriction requirement as including "Ar is optionally substituted phenyl". If Applicants' assumption is mistaken, Applicants request clarification and/or restatement of the restriction requirement as to which groups the omitted

Amendment D
USSN 09/925,883

Attorney Docket R0072B-REG

compounds belong to (e.g., wherein Ar is unsubstituted phenyl, or phenyl substituted with nitro, hydroxy, amino, acylamino, haloalkyl, alkyl, and the like).

Rejection under §112, First Paragraph

Claims 27, 28 and 30 were rejected as lacking enablement under §112, first paragraph. Applicants respectfully traverse.

Applicants submit that the specification is fully enabling for the treatment of all claimed diseases and conditions, as synovitis, myositis, gout, headache, Alzheimer's disease, bursitis, cancers, inflammatory diseases, and pain are all believed to involve the activity of COX-2 in similar and analogous ways. Failure of a competing compound, not within the scope of Applicants' claims, does not establish that Applicants' compounds would be similarly ineffective. However, in the interest of obtaining an earlier issue date, Applicants have amended the claims above to exclude synovitis, myositis, gout, headache, Alzheimer's disease, bursitis, and cancers. Applicants reserve the right to pursue the canceled subject matter in a copending continuation application.

With regard to inflammatory diseases and pain, Applicants submit that these are diseases with common mechanisms of action. Specifically, the compounds of the invention inhibit the enzyme that is common to all inflammatory diseases (and pain), COX-2. Having accepted that the compounds of the invention are enabled for the treatment of arthritis, back pain, dental pain, inflammation associated with sports injuries, ankylosing spondylitis, dysmenorrhea, and premature labor, what basis is there for distinguishing other forms of inflammation or pain?

Rejection Under §112, Second Paragraph

Claims 28 and 29 were rejected as indefinite under §112, second paragraph, on the grounds that several of the specifically-recited disorders are not "diseases", and thus do not conform to the preamble. Applicants appreciate and adopt the Examiner's suggested amendment, changing "disease" to "disease or condition".

Amendment D
 USSN 09/925,883

Attorney Docket R0072B-RLG

In light of the foregoing, Applicants respectfully submit that all rejections of the pending claims have thus been overcome, and that the application has been put into condition for allowance. Applicants hereby request a Notice of Allowance for the same.

Respectfully submitted,



Grant D. Green
 Attorney for Applicants
 Reg. No. 31,259

October 18, 2004

Roche Palo Alto LLC
 Patent Law Dept.
 3401 Hillview Avenue - M/S A2-250
 Palo Alto, CA 94304
 Direct 650-855-5311
 Fax 650-855-5322
 grant.green@roche.com